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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,684	01/22/2002	Francis James Canova JR.	035451-0132 (3645.Palm)	5151
26371	7590	01/02/2004	EXAMINER	
FOLEY & LARDNER 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308			SHENG, TOM V	
			ART UNIT	PAPER NUMBER
			2673	

DATE MAILED: 01/02/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/054,684

Applicant(s)

CANOVA, FRANCIS JAMES

Examiner

Tom V Sheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1, 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As for claim 1, it is not clear what a "non-display element" really is. It could be an area of the display used as a switch, an electro-mechanical switch outside the display area, or a pressure sensitive type of switch also outside the display area.

Claims 10-11 recite the limitation "the handwritten characters" in lines 1-2 in both claims. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites "means for receiving is removed from the display when **activated**" on lines 1-2, but the specification states that the means for receiving is reduced in size or removed from the display when deactivated, page 4, lines 13-15.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1, 8, 9 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Saitoh et al. (US 5,237,327).

As for claim 1, Saitoh teaches a handheld computer system (remote commander 1; see figures 1 and 3), comprising:

a switch (anyone of the mode designating keys 3a);

a user interface (touch panel operating section 4);

a housing (frame as shown of the remote commander 1); and

a display supported by the housing (the touch panel operating section 4 includes a liquid crystal display panel 4c; see figure 2 and column 3, lines 3-7),

wherein the user interface includes an information entry area, wherein the information entry area is activated in response to manipulation of the switch the switch being a non-display element (based on which mode designating key is pressed, then operation keys 4k necessary for the specific mode selected are selectively displayed on the touch panel operating section 4; see column 3, line 32 to column 4, line 14).

As for claim 8, Saitoh teaches a user interface for a handheld computer system, the handheld computer system (remote commander 1; see figures 1-3) comprising a display (liquid crystal display panel 4c) and a touch pad (transparent switch section 4b; column 3, lines 3-7),

the user interface comprising: means (a plurality of contacts selectively provided based on a mode selected; see column 3, lines 20-35) for receiving information at the touch pad and the display; and

means (mode designating keys 3a; see column 3, lines 36 to column 4, line 14)

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for activating and deactivating the means for receiving,

wherein the means for receiving is reduced in size or removed from the display when deactivated and the means for activating and deactivating is not located on the display (the mode designating keys 3a are not on the display panel 4c, and the display of current operation keys 4k are removed and a new set is displayed when a different mode designating key is pressed).

As for claim 9, Saitoh's operation keys 4k read on claimed area assigned for entering information into the handheld computer system.

As for claim 18, Saitoh teaches a method of interfacing with a handheld computer system, the handheld computer system (remote commander 1; see figures 1-3) comprising a display (liquid crystal display panel 4c) and a touch pad (transparent switch section 4b; column 3, lines 3-7),

the method comprising: manipulating a user interface device (mode designating keys 3a) to cause a suitable area (transparent switch section 4b) for receiving handwritten characters to be displayed on the display (liquid crystal display panel 4c) above or behind the touch pad (display panel 4c is behind switch section 4b); and providing information entry on the touch pad (by pressing anyone of the operation keys 4k), wherein the user interface device is not located on the display (mode designating keys 3a are not part of the display; see column 3, line 20 to column 4, line 14).

***Claim Rejections - 35 USC § 103***

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-7, 10-11, 12-17 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saitoh in view of Lopresti et al. (US 5,889,506).

As for claims 2, 3, 12 and 19, Saitoh teaches deactivating a an information entry area by pressing a different mode designating key 3a, since each mode designating key corresponds to a specific set of operation keys 4k. Saitoh does not teach deactivating an information entry area in response to manipulation of the same mode designating key 3a.

Lopresti teaches an enhanced video user interface (figure 1) comprising a control unit 20 and a hand-held remote control 24. Lopresti also teaches a television 22 upon which a video user interface is projected and includes a command bar 32 and a user interactive panel 34 (column 3, line 59 to column 4, line 12). The command bar provides access to various functions similar to Saitoh's mode designating keys 3a.

Specifically, Lopresti teaches access to the command bar by pressing a button on the remote control unit 24, and another press of the button causes the command bar to disappear (figure 7; column 7, lines 46-53). Lopresti's button reads on claimed switch.

One of ordinary skill in the art would recognize that by using a graphical command bar of Lopresti, the number of physical buttons required to select different

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function or instrument can be reduced to just one. Obviously, the negative impact would be an additional selection step required at the touch panel.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to incorporate Lopresti's command bar into Saitoh's remote commander, when reducing the real estate of non-display area is a priority.

As for claim 4, 14, 15 and 20, Lopresti's button is a mechanical button associated with the housing.

As for claim 5, 13 and 21, the squeeze switch is a known invention and incorporation of which does not constitute a new invention.

As for claim 6, Saitoh's operation keys 4k or Lopresti's command bar appears the instant a mode designating key 3a or Lopresti's button is pressed, thus reading on claimed pop-up menu.

As for claim 7, the relative sizes of the information entry area does not make an inventive feature.

As for claims 10-11, Lopresti teaches inputting of signature (figure 9; column 8, lines 14-39) that reads on claimed handwritten characters.

As for claims 16 and 17, certainly a fixed symbol is required when the means/button is a physical button not part of the display panel.

As for claim 22, Saitoh's operation keys 4k read on claimed area assigned for entering information into the handheld computer system.

### ***Conclusion***


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom V Sheng whose telephone number is (703) 305-6708. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Tom Sheng  
December 20, 2003

  
**KENT CHANG**  
**PRIMARY EXAMINER**